

R E M A R K S

Applicants believe that the filing of this document is warranted in accordance with the provisions of §1.116b and c of Title 37 C.F.R. on several grounds, namely:

(1) The document seeks a correction of what appears to be an obvious informality in Paper No. 13 (Final Action dated May 20, 2003). Thus, the latest final rejection of the claims 18-20 relies upon the combined teachings of US patents Nos. 6,022,353 (Fletcher et al.) and 6,267,594 (Hugo). In Paper No. 11 (Official Action dated December 18, 2002), the PTO withdrew the rejection of claims 18-20 as being unpatentable over the combined teachings of Fletcher et al. and Hugo, and the PTO rejected these claims as being unpatentable over the combined teachings of Fletcher et al. and US patent No. 5,427,188 to Fisher. Applicants' response (amendment dated March 10, 2003) discussed the rejection of the claims 18-20 as being unpatentable over the combined teachings of Fletcher et al. and Fisher. However, the Final Action of May 20, 2003 (Paper No. 13) again contains a rejection of the claims 18-20 as being unpatentable over the combined teachings of Fletcher et al. and Hugo (emphasis added by the undersigned).

A clarification and withdrawal of the 3-month term on page titled "Office Action Summary" in Paper No. 13 are respectfully urged. Thus, applicants respectfully request a clarification of the rejection of the claims 18-20, i.e., are these claims finally rejected as being unpatentable over the combined teachings of Fletcher et al. and Hugo or over the combined teachings of Fletcher et al. and Fisher?

(2) The Examiner appears to have disregarded applicants' arguments and explanations in support of the independent claims 1 and 21 and of the claims which refer to these independent claims. The analysis of the patent to Fletcher et al. (which is being relied upon in the final rejection (dated May 20, 2003) of the two independent claims) is incomplete because it fails to point out how and where Fletcher et al. discloses each and every feature of the two independent claims. As concerns the preambles of the claims 1 and 21, please refer to the discussion on pages 4-5 of the Amendment dated March 10, 2003. As concerns the features which are recited in the bodies of the independent claims 1 and 21 but are not disclosed or suggested in Fletcher et al., please refer to the pages 6-8 of applicants' Amendment dated March 10, 2003 and to the 2001 decision by the CA FC in *Brown v. 3M* (265 F.3d 1349, 60 USPQ2d

1376) wherein it was held that:

"To anticipate, any element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim."

This evidently does not apply for the rejection of the two independent claims (1 and 21) which are active in the present application. Therefore, it is quite difficult to explain to a foreign applicant and/or to a foreign applicant's domestic attorney why the decisions by the CA FC are strictly enforced and observed by Examiners in certain Art Units of the US Patent and Trademark Office but are disregarded (as here) by the Examiners in other Art Units.

(3) The undersigned attorney received a position (as a typist and patent draftsman) in New York City in the year 1951, and has drafted his first US patent application in the year 1953. Since 1953, the undersigned has drafted thousands and thousands of US patent applications (probably at least 10,000 which is likely to be much more than the number of patent applications drafted by any living, retired or deceased US patent practitioner). In addition, the undersigned has participated in at least 75 patent litigations and in several hundred proceedings before the Board of Appeals, Board of Patent Interferences and Court of Appeals for

the Federal Circuit.

In the last 53 years, the undersigned has prosecuted, reviewed and inherited (as the present application) numerous cases in which the US Patent and Trademark Office was required or induced or found it advisable to withdraw, revise and/or otherwise correct its decisions, such as Official Actions, final rejections, interpretation of prior art, and so forth. The present application is one of those in which the US Patent and Trademark Office has (voluntarily or upon request by the attorney) revised or will revise its earlier decisions an inordinately large number of times. These include:

(a) Withdrawal of the Notice of Allowance dated March 22, 2002.

(b) Citation of a wrong prior art reference (US patent No. 6,267,594 to Hugo) in the Action of July 1, 2002.

(c) Withdrawal of Hugo and citation of US patent No. 5,427,188 to Fisher (in the Action dated December 18, 2002 = Paper No. 11).

(d) Withdrawal of Fisher and substitution of Hugo (in the Final Action of May 20, 2003 = Paper No. 13).

(e) The last-mentioned Action (Paper No. 13) is expected to be followed by a further Action in which

the PTO will withdraw the final rejection of claims 18-20 as being unpatentable over the combined techings of Fletcher et al. and Hugo.

It is to be borne in mind that such protracted prosecution of this patent application is very expensive to a foreign applicant and/or to a foreign applicant's assignee since the applicant and/or the assignee must pay the fees of his or its domestic attorney(s) as well as those of his or its US patent attorney(s).

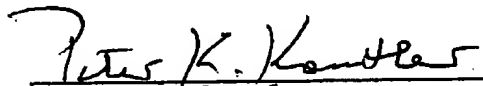
Moreover, if and when the Final Action of May 20, 2003 will be withdrawn (by the Examiner or by the Board), applicants will be compelled to seek an extension of the term of the US patent (if and when granted) since, if the first Notice of Allowance (dated March 22, 2002) would have remained in full force and effect, a patent on the present application would have been granted in the year 2002. Assuming that the PTO will adhere to the final rejection of claims which are presently active in this case, and such rejection will be reversed by the Board or by a competent Federal Tribunal, the patent is likely to be granted late in 2004 or in 2005 (or even later), i.e., with a delay of three years or more.

(4) For the foregoing reasons, the Examiner is most respectfully requested to withdraw the Final Action

of May 20, 2003 and to allow the application with the claims which are presently active therein. Alternatively, the Examiner is respectfully requested to withdraw the rejection of claims 18-20 as being unpatentable over the combined teachings of Fletcher et al. and Hugo, and to replace such rejection with a rejection which will rely upon prior art that can be properly relied upon against applicants' claims. It is to be noted here that the Fisher reference was available to the PTO from the year 1995 on, i.e., prior to the foreign filing date of the Hugo reference and prior to the foreign filing date of the predecessor of the present application.

Receipt of a response to this Paper prior to August 20, 2003 (i.e., prior to expiration of the present term to file a Notice of Appeal) would be greatly appreciated.


Respectfully submitted,



Peter K. Kontler
Reg. No. 20,384
Attorney for Applicants
Telephone: (239) 262-8492
Facsimile: (239) 434-6747
Address:
4401 Gulf Shore Blvd. North
Naples, FL 34103-3450

I herewith certify that the enclosed 7-page document (Amendment under §1.116 of Title 37 C.F.R. dated June 30, 2003) was forwarded to the Examiner, Ms. Shantese L. McDonald, to the private fax number (703-746-3272) in her computer on June 30, 2003. The private fax number was furnished by the Examiner during a telephone conversation which took place on March 11, 2003.

Dated: June 30, 2003


Peter K. Kontler
Reg. No. 20,384
Attorney for Applicants
Marco Steiger et al. (USSN
09/917,998 filed 07/30/2001)
Facsimile: (239) 434-6747
Telephone: (239) 262-8492
Address:
4401 Gulf Shore Blvd. North
Naples, FL 34103-3450